

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLINTON O. FRUITMAN

Appeal No. 2001-1460
Application 09/008,148

ON BRIEF

MAILED

FEB 28 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before STONER, Chief Administrative patent Judge, and FRANKFORT
and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4 through 10, which are all of the claims remaining in this application. Claims 1 through 3 have been canceled.

Appellant's invention relates to an apparatus and method for chemically and mechanically planarizing a surface of a workpiece,

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more particularly, a workpiece in the microelectronics industry. Claims 4 and 9 are representative of the subject before us on appeal, and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Samuelson	4,048,765	Sept. 20, 1977
Ronay	5,752,875	May 19, 1998
	(Effectively filed Dec. 14, 1995)	

In addition to the foregoing prior art, the examiner has also relied upon appellant's prior U.S. Patent No. 5,769,691, issued June 23, 1998, in an obviousness-type double patenting rejection.

Claims 4 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ronay in view of Samuelson.

Claim 4 through 10 additionally stand rejected under the judicially created doctrine of obviousness-type double patenting

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over claims 1, 2, 8-13 and 16-19 of appellant's prior U.S. Patent No. 5,769,691.

Rather than reiterate the examiner's full explanation of the basis for the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 14, mailed October 1, 1999) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 13, filed July 6, 1999) and reply brief (Paper No. 15, filed December 7, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. Upon evaluation of all of the evidence before us, we have reached the determinations which follow.

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Looking first to the examiner's rejection of the appealed claims under the judicially created doctrine of obviousness-type double patenting, we note that the only issue raised on appeal is whether the terminal disclaimer filed by appellant on July 6, 1999 (as an attachment to the brief) complies with the requirements of 37 CFR § 1.321 and thus is adequate to remove or overcome the obviousness-type double patenting rejection.

In Paper No. 16, mailed February 24, 2000, the examiner informed appellant that the terminal disclaimer filed with the brief was not acceptable and was not entered, since the attorney or agent signing the terminal disclaimer was not of record in the application and thus was not authorized to sign a terminal disclaimer. Finding no argument from appellant that the examiner's determination in Paper No. 16 is in error, and no indication in the record of this application that Ms. Laura J. Zeman (who signed the terminal disclaimer submitted on July 6, 1999) is in fact an attorney or agent of record, we will sustain the examiner's rejection of claims 4-10 based on obviousness-type double patenting.

However, we note that appellant filed a new terminal disclaimer on February 8, 2002 (Paper No. 18) and that such terminal disclaimer is signed by an attorney of record. Thus, we additionally REMAND this application to the examiner for consideration of the new terminal disclaimer.

As for the examiner's rejection of claims 4 through 10 under 35 U.S.C. § 103 based on the collective teachings of Ronay and Samuelson, we find appellant's arguments in the brief and reply brief to be persuasive of error on the examiner's part. Like appellant, we are of the opinion that the examiner's reasoning regarding this rejection constitutes an improper hindsight reconstruction based upon appellant's own teachings.

In that regard, we note that Ronay addresses a method of chemically-mechanically polishing aluminum on a semiconductor wafer and, more particularly, addresses the planarization of such semiconductor wafers without damage to the underlying aluminum wiring pattern formed therein. Ronay utilizes a polishing pad of open structure (col. 5, lines 5-21), wherein such open structure includes tracks that permit the polishing particles of the polishing slurry to roll around upon shear from the pad, thereby

providing a maximum surface contact between the polishing particles and the alumina surface on the wafer, but which also prevent the polishing particles from being pressed into the aluminum surface of the wiring pattern and causing damage thereto. By contrast, Samuelson deals with a solid polyurethane polishing and finishing wheel that is used for polishing, finishing and deburring of workpieces formed of steel or other metals, wherein the surface portion of the polishing wheel has some flexibility, but is also said to have "high density and high strength" (col. 5, lines 37-44). In addition, Samuelson describes the polishing wheel as being a cured solid elastomer which is "essentially non-cellular" and seldom contains more than 2 or 3 percent by volume of void spaces so that the density and tensile strength are relatively high (col. 11, lines 49-53).

When we view the collective teachings of the applied references, we concur with appellant's assessment that one of ordinary skill in the art at the time of appellant's invention would have found no teaching, suggestion or incentive in the applied patents for replacing the relatively open structure polishing pad of Ronay with the non-cellular, cured solid elastomer polishing pad of Samuelson. Indeed, the express

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teaching of the desire and need in Ronay for an open structure polishing pad would have provided a strong disincentive to one of ordinary skill in the art for the combination proposed by the examiner.

In accordance with the foregoing, we have sustained the examiner's rejection of claims 4 through 10 under the judicially created doctrine of obviousness-type double patenting, but reversed the examiner's rejection of those same appealed claims under 35 U.S.C. § 103 based on Ronay in view of Samuelson. Since at least one rejection of all of the claims on appeal has been sustained, the decision of the examiner is affirmed.

In addition to affirming the examiner's rejection of one or more claims this decision contains a remand. 37 CFR § 1.196(e) provides that

whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and interferences may enter an order otherwise making its decision final.

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Regarding any affirmed rejection, 37 CFR § 1.197(b)
provides:

(b) Appellant may file a single request for rehearing within
two months from the date of the original decision

The effective date of the affirmance is deferred until
conclusion of the proceedings before the examiner unless, as a
mere incident to the limited proceedings, the affirmed rejection
is overcome. If the proceedings before the examiner does not
result in allowance of the application, abandonment or a second
appeal, this case should be returned to the Board of Patent
Appeals and Interferences for final action on the affirmed
rejection, including any timely request for rehearing thereof.

This application, by virtue of its "special" status,
requires immediate action, see MPEP § 708.01 (Eighth Edition,
Aug. 2001), item (D). It is important that the Board of Patent
Appeals and interferences be promptly informed of any action
affecting the appeal in this case.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)


AFFIRMED AND REMANDED



BRUCE H. STONER, JR.
Chief Administrative Patent Judge



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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